

Remarks

The present amendment is provided in response to the Office action dated November 16, 2007, in which claims 35 and 37-51 were rejected. In the present amendment, claims 35, 42, and 47-51 have been amended. Accordingly, claims 35 and 37-51 are pending in the present application, with claims 35, 42, 47, and 48 being the independent claims. Reconsideration and allowance of pending claims 35 and 37-51 in view of the amendments and the following remarks are respectfully requested.

A. 35 U.S.C. §112

Claims 49 and 51 stand rejected under section 112 as containing new subject matter. Applicant disagrees that new subject matter has been introduced by the submission of claims 49 and 51. 35 U.S.C. §112 states:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

There is no requirement in section 112 for literal support of the claim language. The standard set forth in section 112 is in stead that one skilled in the art be able to make and use the claimed invention. Accordingly, the use of terms in a claim that do not appear in the specification is not, per se, new subject matter. The inquiry is whether one skilled in the art would be able to make and use the claimed invention based on the disclosure in the specification.

Here, claim 49 clarifies that the presented links include first and second human readable references, one to an external location and one to an internal location. Paragraph [0056] defines a link as: A link can be a hyperlink, as commonly used in web pages, or another type of pointer or reference to a document or location within a document. One skilled in the art would understand that a pointer is a computer readable programming language data type whose value refers directly to (or “points to”) another value stored elsewhere in the computer memory using its address. Such a pointer is not “human

readable” but rather intended for processing by the computer and one skilled in the art would certainly understand this and also understand the claim language to require that the presented links not be binary or hexadecimal numbers (e.g., computer memory addresses) that are intended for processing by the computer. Furthermore, the “human readable reference” claim language merely clarifies the use of the defined word link in the particular context of the claim. Finally, the examiner’s clear comprehension of the claim language as demonstrated in paragraphs 20 and 22 of the office action underscores the fact that the statutory requirement has been met by the language of claims 49 and 51.

Applicant has amended claims 49 and 51 for further clarity and asserts that no new matter has been introduced. Regarding claim 51, applicant has removed the “specific spatial location” language, although this too would be understood by one skilled in the art and would enable the skilled person to make and use the claimed invention, e.g., see paragraph 478.

B. 35 U.S.C. §103(a)

Claims 35 and 37-48 stand rejected under section 103(a) as being anticipated by U.S. Patent No. 7,039,860 (“Gautestad”) in view of U.S. Patent No. 6,654,732 (“Mani”). As set forth in MPEP § 2143, in KSR the Supreme Court identified a number of rationales to support a conclusion of obviousness which are consistent with the proper “functional approach” to the determination of obviousness as laid down in Graham. The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The KSR Court noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.

Here, the Office Action relies primarily on Gautestad as teaching the elements of the claims and states that the combination of Gautestad with Mani would have been obvious to a person of ordinary skill in the art. The Office Action cites Mani as teaching inter-document links and intra-document links. This rejection is traversed as follows.

With respect to independent claim 35, Applicant has amended claim 35 to clarify that the links that are generated by searching a group of documents to identify those documents

that match the specification are added to a list document that is stored in a first location. This is in contrast to Gautestad, which only teaches that the search engine results are presented as an HTML formatted screen image. Gautestad does not teach the creation of a list document as required by claim 35.

Furthermore, claim 35 has been amended to require that the list document be published, where publishing comprises modifying the first URL and storing the list document in a second location. Gautestad does not teach storing the list document in any location and certainly does not even contemplate storing the list document in a second location as part of publishing the list document. Gautestad also does not disclose modifying the first URL as part of publishing the list document. The addition of Mani's search engine for querying a repository of XML documents does not cure the deficiencies of Gautestad to disclose these elements of claim 35. Accordingly, Applicant believes that claim 35 and its respective dependent claims are presently in condition for allowance.

Applicant points the Examiner to, e.g., paragraph 57 for support regarding storing the list document in a second location (web pages move from one location to another) as part of publishing the list document and modifying the URL as part of the publish process (automatically modifies URLs to function correctly).

Similar amendments have been made to independent claims 42 and 47. Applicant asserts these independent claims and their respective dependent claims are also now in condition for allowance and a notice of allowance is respectfully requested.

Turning to independent claim 48, this claim has been amended to clarify that the file organizational structure comprises a plurality of linked documents but that the provided location includes only a subset of those linked documents. Applicant points the Examiner to, e.g., paragraph 145 for supporting regarding the location of files for a web page.

Claim 48 additionally requires that only the subset of linked documents at the provided location are searched to identify one or more linked documents that match the specification. This is not taught by either Gautestad or Mani. Both Gautestad and Mani teach searching the entire database for the relevant records that satisfy the query. In contrast, claim 48 is directed toward an embodiment whereby the list documents are

maintained in a file organizational structure that allows a particular location within the file organization structure that houses only a subset of the universe of linked documents to be identified and then searched for linked documents that match the specification.

Claim 48 additionally includes the requirement that the list document be stored in a first location and then moved to a second location as part of the publishing process. Claim 48 also requires that a link in the list document be modified during publication in accordance with the second location. As previously discussed, Gautestad and Mani do not disclose these features. Accordingly, Applicant believes that claim 48 and its respective dependent claims are presently in condition for allowance and a notice of allowance for at least claims 48-51 is respectfully requested.

Conclusion

If the Examiner has any questions or comments regarding the above Amendments and Remarks or believes that a telephone conversation may be useful in advancing prosecution, the Examiner is invited to contact the undersigned at the number listed below.

Respectfully submitted,
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